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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,992	03/02/2004	Sang Woon Suh	1740-000038/US	9678

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EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT PAPER NUMBER

2627

DATE MAILED: 10/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/789,992

Applicant(s)

SUH ET AL.

Examiner

Aristotelis M. Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' response of 7/28/06 has been considered with the following results.

#### ***Claim Objections***

1. Claims 4,10; 12,14-17,19; 21,22,23,24, 26; 28,31,33; 34-40 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The following analysis is made:

With respect to claims 4,10-12;

These depend upon claim 1, which is a product claim. These claims fail to further limit the product.

A1: Claim 4 defines what the physical mark is to define, not further product limitations.

A2: Claim 10 attempts to introduce a servo function – this fails to further limit the product.

A3: Claim 12 – contradicts its parent claim.

#### ***Response to Arguments***

Applicant's arguments filed 7/28/06 have been fully considered but they are not persuasive.

Again, the above objections are made.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 34-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, claim 1 is written as an apparatus claim – however, because no apparatus is recited the examiner at best interprets this claim as a single means, i.e., there must be a recording element/means. This fails as is common – see *In re Hyatt*, 218 USPQ

#### **195.Claim Rejections - 35 USC § 102**

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1,,4,5,13,14,15,20,21,22,27,28,29, 34,35 and 36 are rejected under 35 U.S.C. 102(a) as being anticipated by Sako et al – 2003/0012098.

Sako et al disclose in his description of figure 4, a wobble pit pattern – see the description of element(s) 113.

The examiner interprets the information area to exist, as well as that of a lead-in and out area as well.

Furthermore, the reference is interpreted to depict the physical mark information following the lead-out area.

With respect to claims 4,14,21,28 and 35, that is the intended use of the above references. See the further discussion with respect to copy protection.

With respect to claims 5,15,22,29 and 36, these pits are interpreted as m/s with respect to a hf modulated groove. Such m/s high frequency groove is considered inherent.

With respect to claim 13, the disc is present in the base reference, hence the method of forming as recited is met.

With respect to claim 20, information is reproduced in the above system, and hence the limitation of this claim is met.

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With respect to claim 27, the method limitations as recited are met.

With respect to claim 34, the apparatus limitation is met.

***Response to Arguments***

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

3. Claims 6-10,16,17,23,24,30,31,37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1, 5,13,15,20,22,27,29,34,36, above, and further in view of either Timmerman et al or Ozaki et al.

Either of these secondary references depict/teach:

With respect to claims 6,16,23,30 and 37, they are so aligned.

With respect to claim 7, such a limitation is disclosed in either system.

With respect to claim 8, such is present.

With respect to claim 9, such is disclosed.

With respect to claims 10, 17,24,31 and 38, these pits are detected in the servo stage.

***Response to Arguments***

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

4. Claims 11-12,18,19, 25,26,32,33,39 and 40 are rejected under 35 U.S.C. 103 as being obvious over the art as relied upon above with respect to claim 1 and further considered with either Kuroda et al or Muramatsu et al.

Kuroda et al discusses the rom, and write once type disc formats as well as information indicative of medium type.

Alternatively, Muramatsu et al also discloses such – see col. 1 lines 14-68.

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It would have been obvious to modify the base system of either Timmermans et al or Ozaki et al with the above additional teaching from either Kuroda et al or Muramatsu et al so as to increase the media types the base references are applicable to, i.e., increase of marketed optical discs.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1,13,20,27 and 34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,2,3,12 and 13 of U.S. Patent No. 7102989 in view of the above noted Sako document..

The corresponding patented claims 1,2,3,12 and 13 correspond to the above independent claims 1,13,20,27 and 34 of the pending application. The newly inserted limitation with respect to the physical mark is taught in the above noted Sako et al document.

It would have been obvious to modify the base system with such a physical mark capability- motivation is to provide for the appropriate wobbled pit pattern as a prerecorded signal to ensure proper copy prevention/control/disc type identification and hence permit the disc to be properly reproduced.

The examiner is not making a DB rejection on all pending claims, since a properly filed TD would obviate such.

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**Conclusion**

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-F: 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aristotelis M Psitos  
Primary Examiner

